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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,629

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Mauro Gelli

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EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,629	Applicant(s) GELLI ET AL.	
	Examiner BARBARA J. MUSSER	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-90 is/are pending in the application.
 4a) Of the above claim(s) 65-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 44-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/31/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 44-64, drawn to a method of embossing a web.

Group II, claim(s) 65-74, drawn to a device for embossing a web.

Group III, claim(s) 75-90, drawn to a laminate.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature, coloring, the embossing, then applying adhesive to one sheet is taught by a combination of Biagiotti(WO 99/44814) and Ruppel et al.(U.S. Patent 5,339,730) and thus is not considered a "special technical feature" and therefore the claims do not have a "special technical feature" in common.

3. During a telephone conversation with Mary Breiner on 9/9/08 a provisional election was made with traverse to prosecute the invention of group I, claims 44-64.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 65-90 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 56, it is unclear how many layers of embossing there are on the second web. Claim 55 indicates it is embossed and then claim 56 also indicates it is embossed with a third series of protuberances. It is unclear if these protuberances form the previously mentioned background embossing. For the purposes of examination, they are considered to form the background embossing.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 44-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biagiotti(WO 99/44814) in view of Ruppel et al.(U.S. Patent 5,339,730).

Biagiotti discloses forming an embossed laminate by making protuberances on a first web, making second protuberances on the first web, applying glue to the second protuberances, and joining it to a second web.(Figure 6) The reference does not disclose application of any colored pattern to the laminate. Ruppel et al. discloses that in conventional processes, one or more of the webs are printed on upstream or downstream of the embosser.(Col. 1, ll. 11-13) It would have been obvious to one of ordinary skill in the art at the time the invention was made to print on the first web prior to embossing since Ruppel et al. discloses it is conventional in this art to print on the web either before or after embossing and to print on the same web the adhesive is applied to since there are only two choices.

Regarding claim 45, Biagiotti discloses a pressure roll(311) and an embossing roll(309) and the adhesive is applied to the embossments while the web is still on the embossing roll.(Figure 6)

Regarding claims 46 and 47, the first embossments are a background since they are smaller. The second embossments have greater height and less density.(Figure 7)

Regarding claims 48-50, while Ruppel et al. discloses that conventionally printing occurs before embossing, it also shows embossing a pattern and then printing(113) on the embossed pattern before it is bonded to the second web.(Figure 2) It would have been obvious to one of ordinary skill in the art at the time the invention was made that the printing of a colored pattern could occur after formation of the first embossments since Ruppel et al. shows it is known to emboss a pattern and then print on the embossed web before bonding it to the second web and since this would form a pattern

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in registration with the embossments and would protect the ink between the two webs.(Col. 1, ll. 14-17; Figure 2)

Regarding claims 51 and 56, Biagiotti discloses the background embossing has a density of 10-100 per square centimeter.(Pg. 15, ll. 27-28)

Regarding claims 52 and 57, one in the art would appreciate that the percent of the surface covered by background embossing is within the purview of one skilled in the art. Additionally, Figure ^A shows the embossing wheel and the embossments appear to be spaced one embossment apart. Extrapolating this to all directions, the embossments would cover 1 in 9 spaces or less than 15%.

Regarding claims 53 and 54, Ruppel et al. discloses it is known to color the glue.(Col. 1, ll. 22-25) It would have been obvious to one of ordinary skill in the art at the time the invention was made to color the glue and to make it a different color from the printed pattern since two colors form a more decorative and pleasing pattern than a monochromatic color scheme.

Regarding claim 58, Figure 7 of Biagiotti shows one of the second embossments per at least 6 of the first. Extrapolating that in each direction yields one of the second embossments per 36 of the first, leading to less than 3 of the second embossments per centimeter even for 100 per cm of the first.

Regarding claims 61, 62, and 64, one in the art would appreciate that the pattern for the printing could be any conventional type of pattern and would have been well within the purview of choice of one skilled in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA J. MUSSEY whose telephone number is (571)272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BJM
/B. J. M./
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791